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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,722	03/08/2002	Masahide Ogawa	P 290786 RIG500236-USA-A	7348
909 7590 11/15/2007 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102			EXAMINER BEKERMANN, MICHAEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 11/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/092,722	<b>Applicant(s)</b> OGAWA, MASAHIDE	
	<b>Examiner</b> Michael Bekerman	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/28/2007 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Regarding claim 5**, this claim recites "collecting each discount applied". It is unclear as to how applied discounts may be collected.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 4-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker (WO 00/21005).** Walker teaches a system and method for providing discounts for purchases between different merchants that includes all of the limitations recited in the above claims.

**Regarding claims 4, 8, 11, and 14-16,** Walker teaches offering a discount to a customer when that customer meets certain criteria with 2 (or more) merchants, that criteria including the purchase of specific item(s) from each merchant (Page 15 Lines 16-19, Page 16 Lines 9-16, Page 17 Lines 9-21, and Page 18 Lines 12-18). Walker also teaches a store code identifying each merchant (Figure 8 References 824, 832 and Figure 10 Reference 1024), an item code identifying each product for sale (Figure 10 Reference 1030), and a discount item flag identifying items as being subject to a discount (Figure 10 Reference 1020). Since Walker teaches that a criteria for offering the discount could be a required purchase from a 1<sup>st</sup> merchant and a criteria for redeeming the discount could be a required purchase for a 2<sup>nd</sup> merchant, all items subject to this criteria must have the associated discount item flag. Walker further teaches notifying the purchaser of the obtainable discount (Page 15 Lines 18-19) and applying the discount should the criteria be met (products are purchased from the different respective merchants which is part of the criteria that needs to be met for the discount, so this meets the step of discrimination) (Page 18 Lines 13-16). While Walker teaches this process as taking place in an actual mall (Page 7 Lines 14-16 and Page 8

Lines 5-6), Walker also teaches this as taking place online (Page 8 Lines 7-9 and Page 23 Lines 13-16). Due to the multiple merchants that do business through it, the Internet is a virtual mall.

**Regarding claim 5**, Walker teaches the discount as being applied to any number of items at different retailers (Page 25 Lines 11-16). If a discount is applied to a purchase, the discount is "collected" by the consumer.

**Regarding claims 6, 9, and 12**, if two items are purchased from a merchant (regardless of the discount item flags), both items have been selected for purchase by the consumer.

**Regarding claims 7, 10, and 13**, Walker teaches offering a discount (Figure 10 Reference 1022) for the purchase of one of a set of particular items (Figure 10 Reference 1030) and/or a required purchase price threshold (Figure 10 Reference 1028). If the threshold is set at \$10, and multiple items are listed as required purchases (thus all of which would have discount item flags), one required item priced at \$5 would not have the discount applied while a required item with a higher price of \$15 would. This scenario is supported by Walker and is representative of the claim language.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MB

  
Jeffrey D. Carlson  
Primary Examiner